

EXHIBIT A, PART 1

A Court of Appeal

Lucasfilm Ltd and others v Ainsworth and another

[2009] EWCA Civ 1328

2009 Nov 3, 4, 5;
B Dec 16

Rix, Jacob, Patten LJ

- C *Conflict of laws — Jurisdiction — Copyright — US claimants alleging infringement of copyright by English defendants — Claimants bringing claim in United States for breach of copyright and obtaining judgment in default — Claimants subsequently bringing claim in High Court for breach of US copyright and for enforcement of default judgment — Whether action for breach of US copyright justiciable in England — Whether US default judgment enforceable against defendants in England — Civil Jurisdiction and Judgments Act 1982 (c 27), Sch 1 (as substituted by Civil Jurisdiction and Judgments Act 1982 (Amendment) Order 1990 (SI 1990/2591), art 12(1), Sch 1), art 2*
- D *Copyright — Infringement — Sculpture — First defendant producing helmet for use by US claimants as costume in film — Helmet based on claimants' drawings and models produced using sculpting techniques — Defendants later producing replicas of helmet and advertising them for sale on Internet — Some replica helmets sold to US customers — Claimants bringing claim in United States for breach of copyright and obtaining judgment in default — Claimants subsequently commencing claim in High Court for copyright infringement under English law and for infringement of US copyright and enforcement of US default judgment — Whether model helmet protected by copyright as "sculpture" — Whether action for breach of US copyright justiciable in England — Whether US default judgment enforceable against defendants in England — Whether implied assignment of first defendant's copyright to claimant — Copyright, Designs and Patents Act 1988 (c 48), ss 4, 51 — Civil Jurisdiction and Judgments Act 1982, Sch 1 (as substituted by Civil Jurisdiction and Judgments Act 1982 (Amendment) Order 1990, art 12(1), Sch 1), art 2*

- F In 1976 the first defendant was commissioned by the claimant to make a military-style helmet to be used as a part of a costume in a series of science fiction films. He based the helmet on paintings and drawings and a clay model supplied by the claimants, incorporating his own improvements and using sculpting techniques. In 2004 he and the second defendant company, operating in England, began producing plastic replicas of the helmet for public sale, advertising them on a website. Some of the replica helmets were sold to buyers in the United States of America, where the claimants began proceedings for, inter alia, breach of copyright. The defendants challenged the United States court's jurisdiction but took no further
- G part in the proceedings, which resulted in a default judgment awarding the claimants substantial damages. The claimants then brought proceedings in England seeking (1) damages for infringement of copyright, on the basis that the helmet was protected as a "sculpture" for the purposes of section 4 of the Copyright, Designs and Patents Act 1988¹; (2) enforcement of their United States copyright; and (3) recognition and enforcement of the United States default judgment. The first
- H defendant counterclaimed to enforce his own copyright in the helmet. On the first issue the judge set out a number of factors for determining whether a three-dimensional object was a "sculpture" for the purposes of section 4 which included, in particular, whether the object's visual appeal was part of its purpose, and held

¹ Copyright, Designs and Patents Act 1988, s 4: see post, para 20.
 §51: see post, para 84.

that since the helmet was primarily utilitarian in function it was not a “sculpture” and therefore the defendants had a defence to the claim under section 51 of the Act, which permitted the copying of a design document or model for anything other than an artistic work. On the second issue the judge held that the principles underlying the Brussels Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters (1968)² recognised a distinction between title (for land) and validity and registration aspects (for registrable intellectual property rights) on the one hand and trespass/infringement on the other; that where the subsistence of a foreign copyright was not in issue the English court could determine questions of its infringement if it were appropriate to do so having regard to the doctrine of forum conveniens; and that United States copyright subsisted in the helmet and had been infringed by the defendants. On the third issue the judge held that the United States default judgment was not enforceable in England. On the counterclaim the judge held that it had been implicit in the agreement between the parties that any copyrights in the items produced by the first defendant for the claimants belonged to the claimants and the first defendant was required to assign any such copyrights to them.

On the claimants’ appeal on the first and third issues, on the defendants’ cross-appeal on the second issue and on the first defendant’s application for permission to appeal against the dismissal of his counterclaim—

Held, dismissing the appeal and allowing the cross-appeal, (1) that it was not possible or wise to attempt to devise a comprehensive or exclusive definition of “sculpture” for the purposes of section 4 of the Copyright, Designs and Patents Act 1988 sufficient to determine the issue in every case; that the judge had been right to adopt the multi-factorial approach which he had; that, taking into account the legislative history of section 4, a “sculpture” had to be a work at least intended to be a work of art; that although the helmets had been created using sculpting techniques the manner of their creation did not in the absence of some element of artistic expression make them “sculptures” within the meaning of section 4; that the fact that the helmets functioned as equipment for fictitious characters did not lessen their utilitarian character and lack of artistic purpose; and that, accordingly, the defendants could rely on a defence under section 51 of the 1988 Act to the claimants’ English copyright claim in respect of the first defendant’s use of the claimants’ drawings and model on which he had based his design for the helmet (post, paras 70–72, 75, 77, 80, 82, 87, 209).

Wham-O Manufacturing Co v Lincoln Industries Ltd [1985] RPC 127 and *Breville Europe plc v Thorn EMI Domestic Appliances Ltd* [1995] FSR 77 considered.

Britain v Hanks Bros & Co (1902) 86 LT 764 distinguished.

(2) That article 2 of the Brussels Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, by which persons domiciled in a Convention state were ordinarily sued in the courts of that state, did not confer on the courts of the those states an universal international subject matter jurisdiction in relation to claims in rem against persons domiciled in the European Union; that the rule relating to foreign land, whereby the court had no jurisdiction to entertain an action for determination of the right or its infringement, applied also to intellectual property rights; that there were sound public policy reasons for holding that such rights, whether registered or not, should not be justiciable in the absence of a treaty governing the position; that infringement of an intellectual property right was essentially a local matter involving local policies and local public interest and should be left to local judges; that, further, different countries had conflicting policies relating to intellectual property and enforcement of non-EU rights could involve a clash of those policies; that the judge had been wrong to invoke the doctrine of forum conveniens to assume jurisdiction; and that, accordingly, the court had no

² Civil Jurisdiction and Judgments Act 1982, Sch 1 (as substituted), art 2: see post, para 123.

- A jurisdiction to enforce the claimants' United States copyright (post, paras 105, 129, 148, 175–183, 185–186, 209).
British South Africa Co v Cia de Moçambique [1893] AC 602, HL(E) applied.
Pearce v Ove Arup Partnership Ltd [1997] Ch 293; [2000] Ch 403, CA and
Owusu v Jackson (Case C-281/02) [2005] QB 801, ECJ considered.
- B (3) That an English court would enforce a judgment of a foreign court if the judgment debtor, at the time the foreign proceedings were instituted, were present in the foreign country; that since the selling of goods from one country to another did not amount to the presence of the seller in that country, it was not possible to say that advertising into a foreign country could render the advertiser present there; that the defendants' advertisement of the disputed products on the Internet was not fundamentally different from other methods used by business persons to present themselves and their products when not personally present and did not create, outside the jurisdiction or jurisdictions where the website owners were to be found, the presence partaking in some sense of allegiance which was a necessary ingredient in the enforceability of foreign judgments; and that, accordingly, the claimants' United States default judgment was not enforceable in England (post, paras 192–195, 209).
- C *Adams v Cape Industries plc* [1990] Ch 433, CA applied.
- D (4) Granting permission for, but dismissing, the first defendant's appeal on the counterclaim, that in the circumstances the first defendant's agreement with the claimants necessarily implied an obligation on the former to assign any copyrights to the latter (post, paras 208, 209).
 Decision of Mann J [2008] EWHC 1878 (Ch); [2009] FSR 103 reversed in part.

The following cases are referred to in the judgment of the court:

- Adams v Cape Industries plc* [1990] Ch 433; [1990] 2 WLR 657; [1991] 1 All ER 929, CA
- E *Atkinson Footwear Ltd v Hodgskin International Services Ltd* (1994) 31 IPR 186
Badische Anilin und Soda Fabrik v Hickson [1906] AC 419, HL(E)
Brancusi v United States (1928) TD 43063; 54 Treas Dec 428
Breville Europe plc v Thorn EMI Domestic Appliances Ltd [1995] FSR 77
Britain v Hanks Bros & Co (1902) 86 LT 764
British Leyland Motor Corp'n Ltd v Armstrong Patents Co Ltd [1986] AC 577; [1986] 2 WLR 400; [1986] 1 All ER 850, HL(E)
- F *British South Africa Co v Cia de Moçambique* [1893] AC 602, HL(E)
Caproni v Alberti (1891) 65 LT 785
Catalyst Investment Group Ltd v Lewinsohn [2009] EWHC 1964 (Ch); [2010] Ch 218; [2010] 2 WLR 839; [2010] Bus LR 350; [2010] 1 All ER (Comm) 751
Clarke's Design, In re [1896] 2 Ch 38, CA
Coin Controls Ltd v Suzo International (UK) Ltd [1999] Ch 33; [1998] 3 WLR 420; [1997] 3 All ER 45
- G *Davis (J & S) (Holdings) Ltd v Wright Health Group Ltd* [1988] RPC 403
Designers Guild Ltd v Russell Williams (Textiles) Ltd (trading as Washington DC) [2000] 1 WLR 2416; [2001] 1 All ER 700, HL(E)
Dow Jones & Co Inc v Gutnick [2002] HCA 56; 210 CLR 575; 194 ALR 433
Foster v Driscoll [1929] 1 KB 470, CA
Gesellschaft für Antriebstechnik mbH & Co KG v Lamellen und Kupplungsbau Beteiligungs KG (Case C-4/03) [2006] ECR I-6509; [2006] FSR 967, ECJ
- H *Great Western Railway Co v Owners of SS Mostyn* [1928] AC 57, HL(E)
Griggs Group Ltd v Evans [2005] EWCACiv 11; [2005] FSR 706, CA
Griggs (R) Group Ltd v Evans [2004] EWHC 1088 (Ch); [2005] Ch 153; [2005] 2 WLR 513
Hesperides Hotels Ltd v Aegean Turkish Holidays Ltd [1979] AC 508; [1978] 3 WLR 378; [1978] 2 All ER 1168, HL(E)

- King Features Syndicate Inc v O & M Kleeman Ltd* [1941] AC 417; [1941] 2 All ER 403, HL(E) A
- Konkola Copper Mines plc v Coromin Ltd* [2005] EWHC 898 (Comm); [2005] 2 All ER (Comm) 637; [2005] 2 Lloyd's Rep 555; [2006] EWCA Civ 5; [2006] 1 All ER (Comm) 437; [2006] 1 Lloyd's Rep 410, CA
- Littauer Glove Corp v FW Millington (1920) Ltd* (1928) 44 TLR 746
- London Film Productions Ltd v Intercontinental Communications Inc* (1984) 580 F Supp 47 B
- Metix (UK) Ltd v GH Maughan (Plastics) Ltd* [1997] FSR 718
- Owusu v Jackson* (Case C-281/02) [2005] QB 801; [2005] 2 WLR 942; [2005] 2 All ER (Comm) 577; [2005] 1 Lloyd's Rep 452; [2005] ECR I-1383, ECJ
- Pearce v Ove Arup Partnership Ltd* [1997] Ch 293; [1997] 2 WLR 779; [1997] 3 All ER 31; [2000] Ch 403; [2000] 3 WLR 332; [1999] 1 All ER 769, CA
- Plastus Kreativ AB v Minnesota Mining and Manufacturing Co* [1995] RPC 438
- Potter v Broken Hill Pty Co Ltd* (1906) 3 CLR 479 C
- Pyram Ltd v Models (Leicester) Ltd* [1930] 1 Ch 639
- Ray (Robin) v Classic FM plc* [1998] FSR 622
- Roche Nederland BV v Primus* (Case C-539/03) [2006] ECR I-6535; [2007] FSR 106, ECJ
- Satyam Computer Services Ltd v Upaid Systems Ltd* [2008] EWHC 31 (Comm); [2008] 1 All ER (Comm) 737
- TS Production LLC v Drew Pictures Pty Ltd* [2008] FCAFC 194; 172 FCR 433 D
- Tyburn Productions Ltd v Conan Doyle* [1991] Ch 75; [1990] 3 WLR 167; [1990] 1 All ER 909
- Usher v Barlow* [1952] Ch 255; [1952] 1 All ER 205, CA
- Voda v Cordis Corp* (2007) 476 F 3d 887
- Vogel v R & A Kohnstamm Ltd* [1973] QB 133; [1971] 3 WLR 537; [1971] 2 All ER 1428
- Wham-O Manufacturing Co v Lincoln Industries Ltd* [1985] RPC 127 E
- Wildash v Klein* (2004) 61 IPR 324

No additional cases were cited in argument.

The following additional cases, although not cited, were referred to in the skeleton arguments:

- Hay & Hay Construction Co Ltd v Sloan* (1957) 12 DLR 2d 397 F
- Hensher (George) Ltd v Restawile Upholstery (Lancs) Ltd* [1976] AC 64; [1974] 2 WLR 700; [1974] 2 All ER 420, HL(E)
- Hi-Tech Autoparts Ltd v Towergate Two Ltd* [2002] FSR 254
- Wellington (Duke of), In re, Glentanar v Wellington* [1947] Ch 506; [1948] Ch 118; [1947] 2 All ER 854, CA

APPEAL from Mann J and APPLICATION for permission to appeal

By claim forms the claimants, Lucasfilm Ltd, Star Wars Productions Ltd and Lucasfilm Entertainment Co Ltd, brought actions against the defendants, Andrew Ainsworth and Shepperton Design Studios Ltd, for breach of copyright, passing off and breach of confidence in relation to plastic models of helmets which had featured in the "Star Wars" series of films, and sought to enforce an award of US\$10m for copyright and trade mark infringements made on 26 September 2006 by the United States District Court, Central District of California, Western Division. On 31 July 2008 Mann J (i) held that the helmets did not have an independent copyright as "sculptures" or "works of artistic craftsmanship" and that the defendants therefore had defences under sections 51 and 52 of the Copyright, Designs H

- A and Patents Act 1988; (ii) rejected claims in passing off and breach of confidence and the claim to enforce the United States judgment; but (iii) upheld a claim to equitable ownership of such copyrights as the defendants might have acquired anywhere in the world; and (iv) enforced the claimants' United States copyright by restraining the defendants from advertising in any publication directed to the United States of America or sending to the United States of America replicas of identified props, including in particular the helmets.

By an appellant's notice the claimants appealed with permission of the judge against the decisions that the helmet produced by the first defendant was not a "sculpture" for the purposes of the 1988 Act and that the award of the Californian court was not enforceable in England.

- C By a respondent's notice the defendants cross-appealed against the decision that the claimants' United States copyright was justiciable in England.

By an appellant's notice the first defendant sought permission to appeal against the decision that any copyright he had obtained in, inter alia, the helmet belonged to the claimants.

The facts are stated in the judgment of the court.

- D *Michael Bloch QC* and *Alan Bryson* (instructed by *Harbottle & Lewis LLP*) for the claimants.

It is sufficient for an article to be treated as a sculpture that it is produced by a sculptural process: see *Breville Europe plc v Thorn EMI Domestic Appliances Ltd* [1995] FSR 77; *Wham-O Manufacturing Co v Lincoln Industries Ltd* [1985] RPC 127; *Caproni v Alberti* (1891) 65 LT 785; *Pyram Ltd v Models (Leicester) Ltd* [1930] 1 Ch 39 and *Wildash v Klein* (2004) 61 IPR 324.

- F The test proposed in *Metix (UK) Ltd v GH Maughan (Plastics) Ltd* [1997] FSR 718 (that the article qualifies as a sculpture for the purposes of the Copyright, Designs and Patents Act 1988 if those involved in making the article consider themselves, or are considered to be, artists or if they have been concerned with the article's shape or appearance otherwise than for the purpose of achieving a precise functional effect) is different from that proposed by the judge. [Reference was made to *J & S Davis (Holdings) Ltd v Wright Health Group Ltd* [1988] RPC 403.] The judge's decision cannot be reconciled with *Britain v Hanks Bros & Co* (1902) 86 LT 765.

- C Section 51 of the 1988 Act was intended to prevent the effective assertion of copyright in industrial articles, which were not in themselves artistic works, by the assertion of copyright in design documents or models made in the design or development phase: see *British Leyland Motor Corp'n Ltd v Armstrong Patents Co Ltd* [1986] AC 577.

The judge was wrong to conclude that *Adams v Cape Industries plc* [1990] Ch 433 requires the defendant's physical presence in the foreign jurisdiction for jurisdiction to be established. He was wrong to regard Internet trading as equivalent to methods of cross-border trade in use in 1990.

- H English courts do not decline to determine matters of foreign law because they may raise difficult, or even unsettled, points of foreign law: see *R Griggs Group Ltd v Evans* [2005] Ch 153. The rule in *British South Africa Co v Cia de Moçambique* [1893] AC 602 that the court has no jurisdiction to entertain an action for damages for trespass to foreign land should be

construed narrowly: see *Potter v Broken Hill Pty Co Ltd* (1906) 3 CLR 479 and *Tyburn Productions Ltd v Conan Doyle* [1991] Ch 75. No established rule precludes jurisdiction over a claim for infringement of foreign copyright: see *Pearce v Ove Arup Partnership Ltd* [2000] Ch 403. [Reference was also made to *TS Productions LLC v Drew Pictures Pty Ltd* (2008) 172 FCR 433 and *Pearce v Ove Arup Partnership Ltd* [2000] Ch 403.] A distinction should be drawn between actions which go to the validity of the foreign right and actions which assume its validity and are merely for appropriate relief: see *Satyam Computer Services Ltd v Upaid Systems Ltd* [2008] 1 All ER (Comm) 737; *Hesperides Hotels Ltd v Aegean Turkish Holidays Ltd* [1979] AC 508 and *London Film Productions Ltd v Intercontinental Communications Inc* (1984) 580 F Supp 47. Article 2 of the Brussels Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters (1968) confers personal jurisdiction on the courts of a member state in respect of acts done elsewhere in the European Union. It has the same effect as regards acts done outside the EU: see *Owusu v Jackson* (Case C-281/02) [2005] QB 801. [Reference was also made to *Gesellschaft für Antriebstechnik mbH & Co KG v Lamellen und Kupplungsbau Beteiligungs KG* (Case C-4/03) [2006] ECR I-6509 and *Catalyst Investment Group Ltd v Lewinsohn* [2010] Ch 218.]

Coin Controls Ltd v Suzo International (UK) Ltd [1999] Ch 33 was wrongly decided.

Alastair Wilson QC and George Hamer (instructed by S C Andrew LLP) for the defendants.

The judge gave appropriate consideration to all the material factors concerning the question whether or not the articles were sculpture: see *Designers Guild Ltd v Russell Williams (Textiles) Trading Ltd (trading as Washington DC)* [2000] 1 WLR 2416. [Reference was also made to *Caproni v Alberti* 65 LT 785; *Britain v Hanks Bros & Co* 86 LT 785; *Pyram Ltd v Models (Leicester) Ltd* [1930] 1 Ch 639 and *Wildash v Klein* 61 IPR 324.] If “sculpture” is interpreted too widely many designs which would have been thought to be registrable would be excluded from registration. The Act seeks to apply design law rather than copyright law to artistic works which are design documents or models, thereby reducing the effective period of protection: see *In re Clarke’s Design* [1896] 2 Ch 38.

As to whether the US judgment is enforceable in England on the grounds that the defendants had a sufficient presence in the US for the purposes of private international law, the distinctions which the claimants base on the allegedly different world created by the Internet are insufficient to outweigh the principles in *Adams v Cape Industries plc* [1990] Ch 433. The *Moçambique* principle should apply to intellectual property disputes: see *Coin Controls Ltd v Suzo International (UK) Ltd* [1999] Ch 33, 43, which was not wrongly decided. *Owusu v Jackson* (Case C-281/02) [2005] QB 801 is not authority for extension of subject matter jurisdiction to claims about events outside the EU. [Reference was made to *Atkinson Footwear Ltd v Hodgskin International Services Ltd* (1994) 31 IPR 186 and *Plastus Kreativ AB v Minnesota Mining and Manufacturing Co* [1995] RPC 438, 447.]

Bloch QC replied.

The court took time for consideration.

A 16 December 2009. JACOB LJ handed down the following judgment of the court.

1 This is the judgment of the court. All its members have contributed to each part of it. It is an appeal and cross-appeal from a judgment of Mann J of 31 July 2008 [2009] FSR 103.

B 2 Lucasfilm Ltd and two other claimants (collectively “Lucasfilm”, there being no material distinction between the claimants for present purposes) sue Mr Andrew Ainsworth and his company. Nothing turns on the presence of the latter.

3 Mr Michael Bloch QC and Mr Alan Bryson argued the case for Lucasfilm. Mr Alastair Wilson QC and Mr George Hamer that of Mr Ainsworth.

C *The principal facts*

4 These are set out by the judge at paras 26–84. Most of the detail no longer matters so we confine ourselves to the essentials.

D 5 In the course of making the first “Star Wars” film a number of works were created. They include some paintings and drawings by a Mr McQuarrie showing scenes including stormtroopers in their helmets and armour and a clay model of a stormtrooper helmet made by a Mr Pemberton. Mr Ainsworth was asked to produce a final version in plastic based on the model and McQuarrie works and did so, incorporating his own improvements. In doing so he used what can fairly be called “sculpting” techniques. We say a little more about the detail of what happened when we come to Mr Ainsworth’s cross-claim.

E 6 So far as United Kingdom law is concerned it is accepted that the two-dimensional works produced (eg the scene paintings) are copyright works. Whether the models for the helmet are in themselves copyright works depends on whether they are “sculptures” within the meaning of section 4 of the Copyright Designs and Patents Act 1988.

F 7 Mr Ainsworth has admittedly made and sold copies of the helmet and armour. The appeal has concentrated on the stormtrooper helmet, there being no separate point about the armour or helmets made for other characters. He accepts that he has reproduced the paintings but says he has a defence to an infringement claim under sections 51 or 52 of the 1988 Act.

G 8 As far as the position under United States law is concerned, it is now accepted that US law regards what Mr Ainsworth did as an infringement of various US copyrights. Lucasfilm claims that the English court should itself enforce US copyright law against Mr Ainsworth.

H 9 Lucasfilm has obtained a default judgment for trade mark and copyright infringement in California against him in the sum of US\$20m. That sum sounds strange to English ears given that he only sold about US\$14,500 worth. No less than \$10m of the \$20m is “compensatory damages” by US law. Lucasfilm claims that the English court should recognise and enforce the judgment to the extent of the \$10m “compensatory” element. Perhaps not wanting to seem oppressive, it only seeks to enforce its US judgment to the extent that it cannot succeed on its claim to enforce its US copyrights directly in the English courts.

10 Mr Ainsworth claims that if the work he did in producing the helmet amounts to the creation of a work of sculpture, he is the owner of the copyright in it. A

11 Although there are a mass of other works relied upon by Lucasfilm (eg as to the design of parts of the armour) this case turns on the helmets—as was effectively agreed by the parties. If Mr Ainsworth has infringed copyrights relating to these he loses, if not, not. It is not necessary to go into the detail of other works relied on or referred to in the evidence. B

The holdings of the judge

12 Mann J rejected all of Lucasfilm’s copyright infringement claims under UK law. He held that the models for the helmets did not have an independent copyright as being “sculptures” or “works of artistic craftsmanship” and that Mr Ainsworth had defences under section 51 and 52. C

13 The judge also rejected claims in passing off and breach of confidence and the claim to enforce the US judgment.

14 He upheld Lucasfilm’s claim to equitable ownership of such copyrights as Mr Ainsworth might have acquired anywhere in the world as a result of his work in the creation of the original helmet and rejected Mr Ainsworth’s own conditional cross-claim for infringement. Mr Ainsworth was ordered to execute all necessary assignments of such copyright as may subsist anywhere in the world in his work. D

15 Finally he upheld Lucasfilm’s claim to enforce US copyright here, granting an injunction restraining Mr Ainsworth from advertising in any publication directed to the USA or sending to the USA replicas of identified props—including particularly the stormtrooper helmets. E

The issues on the appeal

16 These have narrowed compared with those before the judge. No appeal is pursued in respect of passing off, breach of confidence or the claim that the prototype helmets were works of artistic craftsmanship. What Lucasfilm does appeal are the findings that the prototypes were not “sculptures” and the findings that there is a defence under section 51 or 52. It also appeals the decision not to enforce the US default judgment. F

17 Mr Ainsworth cross-appeals the decision to enforce the US copyright. He also seeks permission to appeal (for it was refused by the judge and by Jacob LJ provisionally on the papers) the finding that all the copyrights (if any) in the work done by Mr Ainsworth for Lucasfilm belong in equity to Lucasfilm and that he should make a consequential assignment. G

Sculpture

18 This issue is primarily relevant to the defences under sections 51 and 52 of the 1988 Act. It is also of great significance as to the term of protection. If the prototype helmet is a “sculpture” Lucasfilm will get the full term of protection for an artistic work, 70 years from the year of death of the author. If the helmet is not a work of sculpture then there is a much shorter period of protection (under the copyright in the painting and drawings)—broadly 15 years from first marketing of reproductions—a period which has now expired. H

A 19 The issue also determines whether Mr Ainsworth could have acquired his own copyright in the helmets which he produced based on the refinements he made to the facial details when working on the prototype. This is dealt with by the judge at para 36. Lucasfilm contends that the helmets and armour and the toy stormtroopers which were subsequently produced (and which are reproductions of the stormtrooper helmet and armour) are “sculptures” within the meaning of what is now section 4(1) of the 1988 Act.

B 20 Section 4 defines “artistic work” in the following terms:

“Artistic works

C “(1) In this Part ‘artistic work’ means— (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality, (b) a work of architecture being a building or a model for a building, or (c) a work of artistic craftsmanship.

D “(2) In this Part— ‘building’ includes any fixed structure, and a part of a building or fixed structure; ‘graphic work’ includes— (a) any painting, drawing, diagram, map, chart or plan, and (b) any engraving, etching, lithograph, woodcut or similar work; ‘photograph’ means a recording of light or other radiation on any medium on which an image is produced or from which an image may by any means be produced, and which is not part of a film; ‘sculpture’ includes a cast or model made for purposes of sculpture.”

E 21 In order to deal with some of the arguments about the meaning of these provisions it is necessary to say something about the legislative history of this definition. Copyright protection for sculptures was first granted by an Act of 1798 (38 Geo 3, c 71). It was not unlimited. It extended to models or casts of any bust, any part of the human figure, any statue of the human figure or the head of any animal, any part of any animal or the statue of any animal. The word “sculpture” was not used in the Act and the range of models or casts protected seems to reflect 18th century taste and fashion. The first reference to sculpture comes in a subsequent Act of 1814 (54 Geo 3, c 56) (referred to in the chronological table of statutes as the Sculpture Copyright Act) which extended the protection granted by the 1798 Act to

G “any new and original sculpture, or model, or copy, or cast of the human figure or human figures, or of any bust or busts, or of any part or parts of the human figure, clothed in drapery or otherwise, or of any animal or animals, or of any part or parts of any animal combined with the human figure or otherwise, or of any subject being matter of invention in sculpture, or of any alto or basso-relievo representing any of the matters or things hereinbefore mentioned . . .”

H 22 The 1814 Act records in its Preamble that it was passed for giving further encouragement to the “Art of making new models and casts of busts and other things” and for giving further encouragement to such arts. It remained in force until repealed by the Copyright Act 1911 (1 & 2 Geo 5, c 46). This defined an “artistic work” as including “works of painting, drawing, sculpture and artistic craftsmanship, and architectural works of art and engravings and photographs”. A work of sculpture included casts and models: see section 35(1).

23 Section 22 of the 1911 Act provided:

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“(1) This Act shall not apply to designs capable of being registered under the Patents and Designs Act 1907 [(7 Edw 7, c 29)], except designs which, though capable of being so registered, are not used or intended to be used as models or patterns to be multiplied by any industrial process.

“(2) General rules under section 86 of the Patents and Designs Act 1907 may be made for determining the conditions under which a design shall be deemed to be used for such purposes as aforesaid.”

B

24 The 1907 Act gave registered designs a maximum of 15 years’ protection for what it rather confusingly called “copyright in the design”: see section 53. The right was a true monopoly, unlike a copyright which only provides protection against copying. “Design” was defined in section 93 as meaning:

C

“any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined.”

D

25 The position therefore at the time of the 1911 Act was that works of sculpture as defined continued to attract full copyright protection and were not excluded by the operation of section 22 because of the definition of “design” in the 1907 Act. This had been the case since soon after the introduction of copyright protection for designs. The Copyright of Designs Act 1839 (2 & 3 Vict c 17) gave one year’s protection to

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“a new and original design made for the modelling, or the casting, or the embossment, or the chasing, or the engraving, or for any other kind of impression or ornament on any article of manufacture”

F

and three years’ if it was made of metal. This created the potential for works of sculpture to be protected under both the 1814 and the 1839 Acts but this changed when sculpture was excluded from the definition of “design” in the Copyright of Designs Act 1842 (5 & 6 Vict c 100).

26 Sculptures were included in the system of registration for designs under the Copyright of Designs Act 1850 (13 & 14 Vict c 104) but continued to enjoy the period of protection granted by the Sculpture Copyright Acts. The 1850 Act was repealed by the Patents, Designs and Trade Mark Act 1883 (46 & 47 Vict c 57) which granted five years’ protection for a registered design and removed sculptures from the system of registration by defining “design” so as to exclude a design for sculpture within the protection of the Sculpture Copyright Act 1814: see section 60. This was the definition and treatment that was carried forward when the 1883 Act was repealed and replaced by the Patents and Designs Act 1907.

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27 The 1907 Act was amended by the Patents and Designs Act 1919 (9 & 10 Geo 5, c 80) which included a new definition of “Design”. Section 19 provided:

- A “‘Design’ means only the features of shape, configuration, pattern, or ornament applied to any article by any industrial process or means, whether manual, mechanical, or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction, or anything which is in substance a mere mechanical ‘device’.”
- B 28 This definition removed the express exclusion of sculpture and therefore had the effect of excluding a work of sculpture from copyright protection under the 1911 Act unless the design was not used or intended to be used as a model for multiplication by an industrial process: see section 22(1). Rule 89 of the Designs Rules 1920 (SR & O 1920/337) made reproduction in more than 50 single articles as the test of whether there was multiplication by an industrial process. The consequence of this was that
- C sculpture which was not to be mass produced in numbers exceeding 50 retained full copyright protection but could also in theory be protected as a design under the 1919 Act. But, in cases which were not within the exception to section 22(1) (ie models for production in numbers over 50), only registered design protection was available.
- D 29 The consequences of this change caught a number of copyright owners unawares. In *Pyram Ltd v Models (Leicester) Ltd* [1930] 1 Ch 639 a model of a wolf-cub’s head was produced from a papier-mâché mould in order to be used as a totem by the Boy Scouts Association. They failed to register it as a design under what at the time was the 1907 Act and sued for infringement of their copyright under the 1911 Act. Clauson J accepted that the item was an artistic work under the 1911 Act but held that it also fell
- E within the definition of a “design” under the 1907 Act as amended by the 1919 Act. As a consequence of the amended definition of “design”, it was excluded from protection under the 1911 Act and no protection existed for it under the 1907 Act because it had not been registered.
- F 30 On Clauson J’s reasoning, full copyright protection would have ceased in 1911 when the 1911 Act repealed the Sculpture Copyright Act 1814 and so rendered otiose and ineffective the reference in parenthesis to the 1814 Act contained in the definition of design in section 93 of the 1907 Act: see para 24 above. The new definition in section 19 of the 1919 Act did no more than to recognise this.
- G 31 In the *Pyram* case the judge found as a fact that the wolf’s head had been made with the intention of being reproduced in large quantities. There was therefore no room for disputing that it was outside the exception contained in section 22(1) of the 1911 Act. But in *King Features Syndicate Inc v O & M Kleeman Ltd* [1941] AC 417 the owners of copyright in drawings of “Popeye, the Sailor” brought proceedings for infringement of their copyright against the importers of Popeye dolls and other toys. The defendants contended that the copyright in the original work had been lost by the operation of section 22 of the 1911 Act because the designs were
- H capable of registration under the 1907 Act (although not registered) and the plaintiffs had previously licensed other companies to manufacture dolls and other items based on those designs. The House of Lords rejected this argument (which had been accepted by the majority in the Court of Appeal) on the ground that the condition of use or intention to use for multiplication by an industrial process had to be satisfied or not at the date when the design

first came into existence. If it was not satisfied at that time then full copyright protection under the 1911 Act could not be lost by the grant of subsequent licences for the multiple reproduction of the design. A

32 In 1947 the Swan Committee on the Patents and Designs Act recommended that the policy of allowing a copyright owner to be able to retain protection for his work under the 1911 Act after he had consented to the reproduction of the whole or a substantial part of his work as a registered design should be reconsidered particularly in relation to copyright in artistic works. In para 310 of its final report (Cmd 7206) the committee noted that: B

“Our attention has also been directed to the position of works of sculpture. Prior to 1919, these works had always been excluded from the definition of ‘design’ in the design provisions of the Acts. The 1919 Act abolished this exclusion, and the decision in the case of *Pyram Ltd v Models (Leicester) Ltd* [1930] 1 Ch 639 makes it clear that a work of sculpture intended to be reproduced more than 50 times enjoys no protection unless it is registered under the design provisions. Although questions of artistic copyright do not come within our terms of reference, we wish to express the opinion that there seems to be no sufficient reason to draw a distinction between the sculptor and the painter, writer or composer, and that accordingly works of sculpture should be excluded from the definition of designs registrable under the design provisions.” C D

33 The Registered Designs Act 1949 (12, 13 & 14 Geo 6, c 88) therefore added to the definition of a “design” in section 1(3) a further provision in section 1(4) empowering the Board of Trade to make rules for excluding from registration under the Act designs for articles which were primarily literary or artistic in character. E

34 This power was exercised in the form of rule 26 of the Designs Rules 1949 (SI 1949/2368) which provided:

“There shall be excluded from registration under the Act designs to be applied to any of the following articles, namely— (1) works of sculpture other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process. (2) wall plaques and medals. (3) printed matter primarily of a literary or artistic character, including bookjackets, calendars, certificates, coupons, dressmaking patterns, greetings cards, leaflets, maps, plans, postcards, stamps, trade advertisements, trade forms, and cards, transfers, and the like.” F

35 The combination of the 1949 Act and the Rules was therefore effective to exclude the articles specified in rule 26 from registration as designs. The reference in section 22(1) of the 1911 Act to the Patent and Designs Act 1907 fell to be read in accordance with the Interpretation Act 1889 (52 & 53 Vict c 63) as a reference to the 1949 Act: see *Usher v Barlow* [1952] Ch 255. The exclusion from full copyright protection contained in section 22(1) therefore no longer applied regardless of whether the articles specified in rule 26 were intended to be used as models for the multiple reproduction of the design. They remained for all purposes under the umbrella of the 1911 Act. But the position was different in the case of sculptures. As a result of the qualification contained in rule 26(1), an intention to use models or casts for mass production purposes meant that G H

A they continued to attract Designs Act protection and so, to that extent, they continued to be excluded by section 22(1) from full copyright protection. The reference to multiplication by an industrial process in rule 26(1) is the 50-plus test.

B 36 The wording of rule 26(1) was obviously taken from the exception in section 22(1) of the 1911 Act and must therefore be given the meaning explained by the House of Lords in the *King Features* case [1941] AC 417, the effect of which was set out in the Swan Report. A model or cast in respect of which the 50-plus test is satisfied would therefore only be eligible for registered design protection if the use or intention to use existed from the date of its creation.

C 37 When the 1911 Act was repealed by the Copyright Act 1956 (4 & 5 Eliz 2, c 74) transitional provisions were included in Schedule 7 to exclude from protection under the 1956 Act artistic works made before 1 June 1957 which were capable of registration under the Registered Designs Act 1949 and were intended to be used as a model or pattern to be multiplied by any industrial process: see paragraph 8(2) of Schedule 7. Paragraph 8(2) included an express reference to the time when the work was made thereby confirming the construction of section 22(1) of the 1911 Act applied by the House of Lords in the *King Features* case.

D 38 In relation to new works, sculptures remained excluded by the 1949 Act and rule 26(1) of the Designs Rules from registration as designs except in the case of models intended for multiple production and this position was continued following the passing of the 1988 Act. Although section 1 of the 1949 Act was replaced with a new section, the old section 1(4) continues in the form of what is now section 1(5) which provides that: “The Secretary of State may by rules provide for excluding from registration under this Act designs for such articles of a primarily literary or artistic character as the Secretary of State thinks fit.”

E 39 Rule 26 of the Registered Design Rules 1989 (SI 1989/1105) continues to exclude from registration “works of sculpture, other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process”.

F 40 It will be necessary to return to some of this legislative history when considering the defences relied on by Mr Ainsworth under sections 51 and 52 of the 1988 Act. But in relation to the issue of how one should construe the word “sculpture” in what is now section 4(1)(a) of the 1988 Act, two things are clear. The first is that (contrary to some of the arguments addressed to us) one gets little or no real assistance from the relationship between copyright and registered design right in determining the limits of protection which the use of the word “sculpture” was intended to have. We can ignore for the purposes of this appeal the effect of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ 1998 L289, p 28). If one concentrates on the position under the 1949 Act the definition of “design” emphasises that registered designs are intended to protect features of an industrial article which have eye appeal and not merely functional aspects of the design. Features of shape and configuration can be included in the former.

H 41 But a design feature comprising a shape which has eye appeal is obviously capable of including a cast or model for a sculpture. The express exclusion of such casts or models from registered design protection by

rule 26 except for those intended to be used for multiplication by an industrial process indicates that, but for rule 26, all such items could be eligible for dual protection under both the 1988 and the 1949 Acts provided that they have the element of novelty required for registration as a design. A

42 That said, the second point is that the definitions of “design” and “artistic work” are not the same and are concerned to identify different things. A model or cast could be registrable as a design under the 1949 Act if it is new and original and has the necessary features of shape or ornament which create visual appeal. The existence of those features (and only those features) in what might otherwise be a purely functional object are what attract protection. Even where the visual design features are those of shape, a distinction has to be drawn between the features which are part of the design and those which are intrinsic to the article in question: i.e. the difference between the shape of a thing and a thing of that shape: see *In re Clarke’s Design* [1896] 2 Ch 38, 43. B C

43 The emphasis in copyright is different. Copyright protection in artistic works is defined (now in section 4 of the 1988 Act) by reference to various categories of work with no distinction between their aesthetic merits and appeal and their functionality. A graphic work can include a diagram or plan which is designed to have only practical utility. But it is still protected as an artistic work. Equally it can comprise a painting which (however bad it may be in artistic terms) is unlikely to be anything but decorative. The key therefore to copyright protection is that the work created by the author falls within one or other of the descriptions contained in the 1988 Act: i.e. that it is such a work. It does not depend upon a further analysis or identification of its design features. D

44 The issue of construction raised by this appeal has therefore to be determined by reference to the copyright provisions of the 1988 Act themselves. The fact that a model or cast which qualifies as a sculpture may have design features which also entitle it to registration as a design in those respects tells one little about how to define the limits of copyright protection. They are simply different issues. A work of sculpture in the traditional fine art sense would undoubtedly have the qualities of eye appeal necessary to make its shape registrable as a design. But the converse does not follow. A principally utilitarian object with design features which could attract registered design protection is not necessarily a work of sculpture under the 1988 Act. E F

45 The helmet and armour were made in 1976 when the relevant definition of “artistic work” was that contained in section 3 of the 1956 Act. This included paintings, sculptures, drawings, engravings and photographs irrespective of artistic quality and is not therefore materially different from the provisions of section 4 of the 1988 Act. It is common ground that the substance of these provisions has not changed between 1911 and the present day. For convenience, we will therefore refer to the provisions of section 4. G

46 Although this defines an artistic work, there is no definition of sculpture beyond the direction that it includes a cast or model made for the purposes of sculpture. The closest one ever gets to a more comprehensive definition is in the Sculpture Copyright Act 1814 which specified in some detail the type of sculptures or models which qualified for protection. Although there is no definition of sculpture as such even in that statute, it is clear from the words used that the Act was concerned with sculpture in its H

A traditional and conventional sense of a work of art. That much is apparent both from the terms of the preamble to the Act and from the description of the types of work included.

47 Notions of what constitutes a work of sculpture have expanded over the years. In *Wham-O Manufacturing Co v Lincoln Industries Ltd* [1985] RPC 127, 155–156, Davison CJ quoted the *Encyclopaedia Britannica*:

B “In the *New Encyclopaedia Britannica*, vol 16, p 421 [now 15th ed (1992), vol 27, p 42] there appears an article on the ‘Art of Sculpture’.
C The following passages are of some interest: ‘Sculpture is not a fixed term that applies to a permanently circumscribed category of objects or sets of activities. It is, rather, the name of an art that grows and changes and is continually extending the range of its activities and evolving new kinds of objects. The scope of the term is much wider in the second half of the
D 20th century than it was only two or three decades ago, and in the present fluid state of the visual arts, nobody can predict what its future extensions are likely to be. Certain features, which in previous centuries were considered essential to the art of sculpture, are not present in a great deal of modern sculpture and can no longer form part of its definition. One of the most important of these is representation. Before the 20th century,
E sculpture was considered a representational art; but its scope has now been extended to include non-representational forms. It has long been accepted that the forms of such functional three-dimensional objects as furniture, pots and buildings may be expressive and beautiful without being in any way representational, but it is only in the 20th century that non-functional, non-representational, three-dimensional works of art have been produced . . . 20th century sculpture is not confined to the two
F traditional forming processes of carving and modelling or to such traditional natural materials as stone, metal, wood, ivory, bone and clay. Because present-day sculptors use any materials and methods of manufacture that will serve their purposes, the art of sculpture can no longer be identified with any special materials or techniques. Through all of these changes there is probably only one thing that has remained constant in the art of sculpture, and it is this that emerges as the central and abiding concern of sculptors: the art of sculpture is the branch of the visual arts that is especially concerned with the creation of expressive form in three dimensions.’ ”

Likewise the dictionary definitions of “sculpture” recognise that taste has changed. In the *Shorter Oxford English Dictionary* it is described as:

G “Originally, the process or art of carving or engraving a hard material so as to produce designs or figures in relief, in intaglio, or in the round. In modern use, that branch of fine art which is concerned with the production of figures in the round or in relief, either by carving, by fashioning some plastic substance, or by making a mould for casting in metal . . .”

H 48 The recognition of abstract shapes as works of art was established early in the 20th century if not before. In 1928 the sculptor Constantin Brancusi successfully argued that his bronze sculpture “Bird in Flight” was exempt from US import duties (Customs wanted to charge on the basis of its scrap metal value!) as a sculpture and work of art: see *Brancusi v United*

States (1928) TD 43063. Today no one would dispute that abstract sculpture is a branch of the fine arts. A

49 But the word sculpture can also be used to describe the process by which an object is created. Most usually this will consist of moulding or carving the relevant material into the desired shape or, in the case of a metal cast sculpture, of creating the necessary cast or mould.

50 The latter process is not, of course, confined to works of art. Casting or moulding is an industrial process commonly used where the end product is made of plastic or metal of some kind. It is used in the production of millions of ordinary household objects, none of which would usually be described as sculptures. A motor car is but one obvious example. Some would have qualified for protection as registered designs so as to be excluded under section 22(1) of the 1911 Act. But would they have qualified as “sculpture”? B C

51 The judge gave a clear no to this question. His view was that the stormtrooper helmet, although created by a process of moulding, was primarily utilitarian in function [2009] FSR 103, paras 121–122:

“121. First, the original stormtrooper helmet. This has, as its genesis, the McQuarrie drawings. The purpose of the helmet was that it was to be worn as an item of costume in a film, to identify a character, but in addition to portray something about that character—its allegiance, force, menace, purpose and, to some extent, probably its anonymity. It was a mixture of costume and prop. But its primary function is utilitarian. While it was intended to express something, that was for utilitarian purposes. While it has an interest as an object, and while it was intended to express an idea, it was not conceived, or created, with the intention that it should do so other than as part of character portrayal in the film. That, in my view, does not give it the necessary quality of artistic creation inherent in the test suggested by Laddie J. Not everything which has design appeal is necessarily a sculpture. I think that the ordinary perception of what is a sculpture would be over-stretched by including this helmet within it, and when rationalised the reasons are those just given. It is not that it lacks artistic merit; it lacks artistic purpose. I therefore find that the Stormtrooper helmet is not a sculpture. D E F

“122. The same reasoning applies to the armour, and to the other helmets. They all shared the same sort of original purpose.”

52 He took the same view, at para 123, about the toy stormtroopers:

“Next, it is necessary to consider the toy Stormtroopers, and other characters, which are taken as being reproductions of the armour and helmets for the purposes of section 52. These are, as already described, articulated models which are sold as toys and which are intended for the purposes of play. Play is their primary, if not sole, purpose. While their appearance is obviously highly important (if they did not look like the original, the child would not be so interested) they are not made for the purposes of their visual appearance as such. While there is no accounting for taste, it is highly unlikely that they would be placed on display and periodically admired as such. The child is intended to use them in a (literally) hands-on way, in a form of delegated role play, and that is doubtless how they are actually used. That means, in my view, they are G H

- A not sculptures. They can be distinguished from the model in *Britain v Hank Bros & Co* (1902) 86 LT 764 which apparently had a significant element of being admirable for its own visual sake. That does not apply to the Stormtrooper, whose only real purpose is play. In reaching this conclusion I am not saying that the *Britain* model is better at what it portrays than the Stormtrooper model. That would be to make judgments about artistic quality, which the statute understandably forbids. It is making a judgment about whether there is anything in the model which has an artistic essence, in the sense identified above. I conclude that there is not.”
- B

- 53 In order to reject their classification as sculpture the judge concentrated on purpose. Purely functional items (even though well designed and visually attractive) did not, in his view, qualify as sculptures because they were not created primarily for the purpose of their visual appeal. Essentially functional objects should look to protection for their visual merits as registered designs.
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- 54 In putting forward this test the judge was expressly conscious of the need not to make value judgments about the artistic quality of the designs involved. The definition of “artistic work” in the Copyright Acts makes that impermissible. But, after a review of the authorities, he set out a list of guidelines which he considered could be derived from the cases. We set it out verbatim, from para 118:
- D

- “From those authorities, and those approaches, a number of guidance factors can be extracted. I call them guidance rather than points of principle, because that gives them the right emphasis. The judges deciding the cases have not sought to lay down hard and fast rules in an area where subjective considerations are likely to intrude, and I will not attempt to do so either. However, I do think the following points emerge from the cases or from the concepts involved: (i) Some regard has to be had to the normal use of the word. (ii) Nevertheless, the concept can be applicable to things going beyond what one would normally expect to be art in the sense of the sort of things that one would expect to find in art galleries. (iii) It is inappropriate to stray too far from what would normally be regarded as sculpture. (iv) No judgment is to be made about artistic worth. (v) Not every three-dimensional representation of a concept can be regarded as a sculpture. Otherwise every three-dimensional construction or fabrication would be a sculpture, and that cannot be right. (vi) It is of the essence of a sculpture that it should have, as part of its purpose, a visual appeal in the sense that it might be enjoyed for that purpose alone, whether or not it might have another purpose as well. The purpose is that of the creator. This reflects the reference to ‘artist’s hand’ in the judgment of Laddie J in *Metix (UK) Ltd v GH Maughan (Plastics) Ltd* [1997] FSR 718, with which I respectfully agree. An artist (in the realm of the visual arts) creates something because it has visual appeal which he wishes to be enjoyed as such. He may fail, but that does not matter (no judgments are to be made about artistic merit). It is the underlying purpose that is important. I think that this encapsulates the ideas set out in the reference works referred to in *Wham-O* [1985] RPC 127 and set out above (and in particular the *Encyclopaedia Britannica*). (vii) The fact that the object has some other
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use does not necessarily disqualify it from being a sculpture, but it still has to have the intrinsic quality of being intended to be enjoyed as a visual thing. Thus the model soldier in *Britain* might be played with, but it still, apparently, had strong purely visual appeal which might be enjoyed as such. Similarly, the Critters in *Wildash v Klein* (2004) 61 IPR 324 had other functions, but they still had strong purely visual appeal. It explains why the Frisbee itself should be excluded from the category, along with the moulds in *Metix* and *J & S Davis (Holdings) Ltd v Wright Health Group Ltd* [1988] RPC 403. It would also exclude the wooden model in *Wham-O* and the plaster casts in *Breville Europe plc v Thorn EMI Domestic Appliances Ltd* [1995] FSR 77, and I would respectfully disagree with the conclusions reached by the judges in those cases that those things were sculptures. Those decisions, in my view, would not accord with the ordinary view of what a sculpture is, and if one asks why then I think that the answer is that the products fail this requirement and the preceding one—there is no intention that the object itself should have visual appeal for its own sake, and every intention that it be purely functional. (viii) I support this analysis with an example. A pile of bricks, temporarily on display at the Tate Modern for two weeks, is plainly capable of being a sculpture. The identical pile of bricks dumped at the end of my driveway for two weeks preparatory to a building project is equally plainly not. One asks why there is that difference, and the answer lies, in my view, in having regard to its purpose. One is created by the hand of an artist, for artistic purposes, and the other is created by a builder, for building purposes. I appreciate that this example might be criticised for building in assumptions relating to what it seeks to demonstrate, and then extracting, or justifying, a test from that, but in the heavily subjective realms of definition in the artistic field one has to start somewhere. (ix) The process of fabrication is relevant but not determinative. I do not see why a purely functional item, not intended to be at all decorative, should be treated as a sculpture simply because it is (for example) carved out of wood or stone.”

55 Mr Bloch appeals against this analysis by the judge and his application of it to the stormtrooper items on essentially two grounds. He contends that the definition of “artistic work” in the Copyright Acts since 1911 concentrates on what the specific objects are rather than on whether they have any particular artistic qualities or merit. The test is therefore essentially descriptive. What they are must depend, he says, on how they were made. A drawing is no more than the product of the draftsman’s skill applying a particular technique. Artistic or visual purpose is irrelevant to its qualifying as a drawing. The same approach should be used in respect of sculpture. If the object has been sculpted by a physical process to which that description can be applied then the outcome should be a sculpture. Nothing more is needed. In this case the helmets and armour were made after moulds had been carved to the required shape and then used to create the finished article.

56 But he also submits that even if the judge’s test is right and the object has to be made in order to display some kind of visual appeal then the helmet and armour qualify. They were designed to project to the audience for the film a representation of a fictional soldier whose character could be derived

A from the image of the design itself. They are not real helmets and suits of armour. They were, Mr Bloch submits, purely representational in character and never had any utility beyond that of a film prop. But, in that capacity, they were designed to be highly visual and embody a considerable level of artistic skill and design.

B 57 It is convenient at this point to examine the cases which provide the foundation for the judge's test. They begin with *Caproni v Alberti* (1891) 65 LT 785: a case under the Sculpture Copyright Act 1814. The defendant copied three casts made by the plaintiff of various arrangements of fruit and leaves. The defence was that the 1814 Act did not refer to casts of flowers, leaves or fruit and that such casts did not fall within the words "any subject being matter of invention in sculpture". It was not suggested that the casts which were copied were not otherwise works of sculpture. The judge
C rejected this argument but his decision offers no real guidance as to what is necessary to constitute a sculpture. He found that the cast had been produced by carving an artistic reproduction of the fruit and leaves so that this was not, on any view, a borderline case.

D 58 The next decision chronologically is *Britain v Hanks Bros & Co* (1902) 86 LT 765. This also involved a claim to copyright under the 1814 Act. The defendants made copies of various metal models of soldiers produced by the plaintiffs. Their claim to copyright in these items was disputed. The defendants' argument was that the 1814 Act applied only to substantial works of art and not to metal toys of no artistic merit. Wright J directed himself that the question whether the model figure fell within the Act had to be decided upon evidence as to its artistic character. The models were of real soldiers and were found by the judge to be artistic
E productions of the mounted yeoman they depicted.

F 59 It is difficult again to take too much from this case. It is clear that the judge rejected the defendants' contention that the models were mere toys of no artistic merit. On his view, the metal figures produced therefore qualified as sculptures or models of the human figure within the meaning of the 1814 Act. They appear to have been high quality lead soldiers cast from a model which had been made with recognisable artistic skill. It was certainly
G the view of the Copyright Committee of the British Board of Trade ("Gregory Committee") which reported in October 1952 (Cmd 8662) and recommended various changes to the Copyright Act that toy soldiers and other models did not qualify for copyright protection under the 1911 Act because of the operation of section 22(1) and Design Rule 26. Their only protection would be as registered designs assuming that they could satisfy
H the requirement of novelty. But, as mentioned earlier, this involves an acceptance that they would otherwise qualify as works of sculpture. It is, however, clear from the report that the Gregory Committee had in mind toy soldiers made from a prototype model which had the qualities necessary to make it a work of sculpture. This certainly seems to be consistent with the view of the judge in *Britain v Hanks Bros & Co* about the quality of the models he was considering. On this basis, that case was concerned with something which was not merely a toy and which, in the hands of a collector, might not be used for that purpose at all. By comparison, the toy stormtroopers were not replicas of real soldiers and were sold essentially for use as toys. The judge was not presented with evidence about how they were made or whether the prototype could itself be regarded as a sculpture.

All we know is that they were reproductions in miniature of the full-sized armour and helmet. A

60 We have already mentioned the decision of Clauson J in the *Pyram* case [1930] 1 Ch 639 where the plastic model of the wolf cub's head was held to be a sculpture within the meaning of the 1911 Act. The case was primarily concerned with the effect on copyright protection of the amendment to the definition of "design" in the Patents and Designs Act 1907. Given the judge's view about the effect of this on section 22(1), it was not necessary to decide whether the model of the head was a sculpture within the meaning of the 1911 Act and the judge proceeded on the assumption that it was. The case does not therefore really assist on the point that we have to consider, although we have no reason to doubt its correctness. The object in question was an artistic creation of an animal's head which was in a real sense a sculpture. B C

61 The next case considered by Mann J was the decision of Falconer J in *Breville Europe plc v Thorn EMI Domestic Appliances Ltd* [1995] FSR 77. The plaintiff company claimed copyright in various plastic shapes which they had produced in order to create moulds for the heated plates in a sandwich toaster. Falconer J did not have to consider the question whether the plastic shapes amounted to sculptures because he had already found that the defendants had not appropriated the plaintiff's designs contained in their drawings in producing their own machine. But he said, at p 94: D

"Turning to the plaster shapes or sculptures, the defendants contended that these were not sculptures within the meaning of section 3 of the Copyright Act [1956] on the ground, as I understand Mr Young, that they were purely mechanical or functional devices and he referred me to section 1 of the definition of 'sculpture' in the original statutory provision relating to copyright in sculptures, section 1 of the Sculpture Copyright Act 1814, which is to be found reproduced in *Laddie, Prescott & Vitoria's Modern Law of Copyright*, p 671. I do not see why the word 'sculpture' in section 3 of the Copyright Act 1956 should not receive its ordinary dictionary meaning except in so far as the scope of the word is extended by section 48(1) which provides that "sculpture" includes any cast or model made for the purposes of sculpture'. The *Concise Oxford Dictionary* defines sculpture as the 'Art of forming representations of objects etc or abstract designs in the round or in relief by chiselling stone, carving wood, modelling clay, casting metal, or similar processes; a work of sculpture', a definition forming the basis of para 3.15 on 'sculptures' in the textbook just mentioned where it is suggested that: 'Since copyright may subsist irrespective of artistic quality it would seem that, for example, carved wooden patterns intended for the purpose of casting mechanical parts in metal or plastic might well be susceptible of protection, although the point has not yet received much attention from practitioners.' E F G

62 As Mann J recognised, this case would assist Lucasfilm because it rests on the method of production of the item in question rather than its purpose. Falconer J relied on the decision of the New Zealand Court of Appeal in *Wham-O Manufacturing Co v Lincoln Industries Ltd* [1985] RPC 127. There it was held that a preparatory wooden model for what became the Frisbee was protected by copyright as a sculpture even though H

A the finished article (which was made in plastic by a process of injection from a metal mould based on the wooden model) could not be one.

63 Davison CJ said, at pp 156–157:

B “One must ask in the present case, what was the original work of the author which created the article sought to be classed as a sculpture? It was not directly the creation of the final disc. It was the creation variously of drawings, wooden models and finally dies or moulds from which the finished plastic product was formed. It would seem that where a model which is a sculpture has been created and a cast or mould is later made from that model for the purposes of reproducing the model in metal and plastic or some other form then the articles so produced may be classified as sculptures. But it appears to us to be straining the meaning of the word ‘sculpture’ to apply it to the discs produced by the injection moulding process used in the present case where the moulds concerned have simply been created by a process of engraving and no original model has been created. Copyright subsists in ‘original works’—see section 7 [of the Copyright Act 1962 (NZ)]—but no original work in the nature of the finished disc has been created before the injection moulding process has created them. We do not overlook that the definition of sculpture in section 2 of the Act ‘includes any cast or model made for purposes of sculpture’. But that is a different matter from a cast or model used to make the sculpture. Furthermore it appears to be implicit in the definitions of sculpture to which we have already referred and from the article in the *New Encyclopaedia Britannica*, particularly the passage reading: ‘The art of sculpture is the branch of the visual arts that is especially concerned with the creation of expressive form in three dimensions’ that sculpture should in some way express in three-dimensional form an idea of the sculptor. It seems to us inappropriate to regard utilitarian objects such as plastic flying discs, manufactured as toys, by an injection moulding process, as items of sculpture for the purposes of the Copyright Act. They lack any expressive form of the creator and any idea which the creator seeks to convey. In the result, we are unable to hold that the final plastic products—the discs—are sculptures in terms of the Act and entitled to copyright protection as sculptures.”

64 Mann J thought that the distinction drawn between the original prototype model and the finished product was somewhat arbitrary. But, correct or not, it does not arise in this case. The helmet and armour were produced by using a mould which was carved by Mr Ainsworth in order to reproduce the designs contained in the McQuarrie pictures and the clay model made by Mr Pemberton. If the finished products are sculpture then so was the mould used to create them. The New Zealand Court of Appeal accepted that this would have been the case in *Wham-O Manufacturing Co v Lincoln Industries Ltd* [1985] RPC 127 had the mould itself been carved or sculpted rather than merely engraved. What therefore constituted the essential distinguishing factor between the wooden prototype and the finished product in that case was the court’s definition of sculpture to exclude merely utilitarian objects such as the Frisbee.

65 We are not concerned on this appeal with whether the McQuarrie paintings or the Pemberton clay models were artistic works, though the

paintings at least obviously were. The sculpture issue relates only to the articles (the helmet and the armour) which Mr Ainsworth produced. To qualify as artistic works they have to be sculpture. If they are, then the defences under sections 51 and 52 of the 1988 Act are not available to him. We have some difficulty in accepting that the wooden model of the Frisbee should, on the reasoning of the Court of Appeal in the *Wham-O* case, have been accorded a different treatment to that of the plastic Frisbee which it was used to design and create. As a prototype, it was essentially utilitarian in nature in that it embodied a design for the well-known toy. Put simply, it was a model of a Frisbee and nothing else. It was not intended to be a depiction of any animate object (like the wolf-cub's head in the *Pytram* case [1930] 1 Ch 639) nor was it made as the model for an abstract work of art. It was therefore far removed from the creation of expressive form described in the extract from the *New Encyclopaedia Britannica* quoted by Davison CJ in his judgment.

66 The same goes for the plastic shapes considered by Falconer J in the *Breville* case [1995] FSR 77. No ordinary citizen—indeed no ordinary lawyer—would regard a sandwich toaster or any part of it as a work of sculpture—even if it did produce “scalloped” sandwiches. So why should a copyright lawyer take a different view? A total or almost total emphasis on the manner of creation, as in the *Breville* case and *Wham-O* case [1985] RPC 127 produces a result which offends common sense and in our view is wrong. There must, as Mann J said, be some element of artistic expression however unsuccessful.

67 It is unnecessary to say anything about the decision of Whitford J in *J & S Davis (Holdings) v Wright Health Group Ltd* [1988] RPC 403 which concerned a model of a dental impression tray. The judge rejected the submission that it was a sculpture largely on the grounds of its ephemeral nature. The only remarkable thing about the case is that anyone could have thought the work in question could remotely be considered a “sculpture”.

68 But the decision of Laddie J in *Metix (UK) Ltd v GH Maughan (Plastics) Ltd* [1997] FSR 718 is more interesting. Copyright was claimed in some moulds used for making cartridges for what are described as flow mixers. The cartridges had the appearance of a double-barrelled hypodermic syringe through which different chemicals were passed using a plunging mechanism and then mixed to create a chemical reaction. The design was obviously intended to have a purely industrial application but the plaintiff sought permission to amend its pleadings to allege copyright infringement based on the moulds being works of sculpture. Laddie J refused the application. He said, at pp 721–722:

“The law has been bedevilled by attempts to widen out the field covered by the Copyright Acts. It is not possible to say with precision what is and what is not sculpture, but I think Mr Meade was close to the heart of the issue. He suggested that a sculpture is a three-dimensional work made by an artist's hand. It appears to me that there is no reason why the word ‘sculpture’ in the 1988 Act, should be extended far beyond the meaning which that word has to ordinary members of the public. There is nothing in the particulars in this case which suggests that the manufacturers of these moulds considered themselves, or were considered by anybody else, to be artists when they designed the moulds or that they

A were concerned in any way with the shape or appearance of what they were making, save for the purpose of achieving a precise functional effect. Nothing in the particulars given here suggests that any consideration of appeal to anything other than functional criteria was in mind or achieved. In these circumstances, it appears to me that there is no arguable case pleaded for the existence of sculpture copyright in the moulds for these products and I will not allow the statement of claim containing such a claim to be served on TAH (Europe) Inc.”

69 Finally, there is the Australian case of *Wildash v Klein* (2004) 61 IPR 324 which concerned three-dimensional depictions of animals made out of wire. Some of these were also functional in that they incorporated a candle holder but all were decorative. Angel J held, at paras 11–12, that they were sculpture:

C “11. I am satisfied that the works in question are sculptures. As Pincus J said in *Greenfield Products Pty Ltd v Rover-Scott Bonnar Ltd* (1990) 95 ALR 275, 284; 17 IPR 417, 427: ‘Although the definition of “sculpture” is not exhaustive, in so far as the word remains undefined it must be given its ordinary meaning, in accordance with orthodox principles of construction.’ In *Lincoln Industries Ltd v Wham-O Manufacturing Co* [1984] 1 NZLR 641, 662; 3 IPR 115, 131 the New Zealand Court of Appeal concluded that ‘sculpture should in some way express in three-dimensional form an idea of the sculptor’. Having said that it ‘is not possible to say with precision what is and what is not sculpture’, Laddie J in *Metix (UK) Ltd v GH Maughan (Plastics) Ltd* [1997] FSR 718, 722 concluded that at ‘the heart of the issue . . . a sculpture is a three-dimensional work made by an artist’s hand. It appears to me that there is no reason why the word ‘sculpture’ in the [UK] Act, should be extended far beyond the meaning which that word has to ordinary members of the public.’

D “12. I am satisfied that the works in question are ‘sculptures’. They are three-dimensional craft pieces hand made with a degree of skill in the medium employed which are designed to have aesthetic appeal to potential purchasers. That some of the works in this case are also functional, such as the wall and table candle holders and ‘mozzie coil’ holders, does not prevent them being ‘sculptures’ within the meaning of that term in the Act. Although in *Wham-O Manufacturing Co*, the New Zealand Court of Appeal concluded that it was ‘inappropriate to regard utilitarian objects such as plastic flying discs, manufactured as toys, by an injection moulding process, as items of sculpture for the purposes of the Copyright Act’, this was so because ‘They lack[ed] any expressive form of the creator and any idea which the creator seeks to convey’: [1984] 1 NZLR 641, 662; 3 IPR 115, 131. The works in question here demonstrate the expression of such ideas.”

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H 70 Against this background, we can return to the judge’s guidelines which are quoted in para 54 above and to Mr Bloch’s criticisms of them. The first point concerns the normal use of the word “sculpture”. Most of the cases proceed on the footing that one should not stray too far from the ordinary meaning of the word but there is considerable disagreement as to what that is. One of the difficulties is that the word can be used to describe

both the physical process of moulding or carving necessary to create the finished object and that object itself. Copyright has, of course, to exist in the product of one's skill and labour. Not in the skill and labour itself. In looking therefore at the finished article, it seems to us wrong to interpret the use of the word "sculpture" in the 1911 Act (and therefore in succeeding Copyright Acts) divorced from the earlier legislative history. The 1814 Act was clearly concerned to identify sculpture as an artistic work. Its transposition into a wider category of "artistic work" under the 1911 Act does not mean that one can ignore that context. Although some of the items included in the list such as a map or diagram may have a high level of functionality that should not be used as a guide to the interpretation of every item which the statutory definition contains. Sculpture, like painting (however good or bad it may be), does connote the work of the artist's hand and the visual purpose attributed to it by the judge in this case. Put simply, it has, broadly speaking, to be a work at least intended to be a work of art.

71 We therefore accept points (i)–(vi) on the judge's list. Mr Bloch criticises the reference in point (v) to the three-dimensional representation of a concept on the largely metaphysical basis that all things in the world are representations of a concept. But that seems to be an issue about terminology. What the judge was referring to is clearly set out in the second sentence of that paragraph. Mr Bloch declined to accept that the well-designed saucepan or car would not be a sculpture but we think that this merely serves to confirm the correctness of the point made by the judge.

72 In point (vii) Mann J deals with questions of the object's utility. This is in many ways the most important and difficult issue because it highlights the existence of a grey area in which, even on the approach outlined in points (i)–(vi), there may be difficulties in drawing the line between sculpture and an object which, though well designed, does not qualify as such. Mr Bloch submits that the creation of these difficulties is due to the judge's concentration on the artistic or visual purpose of the work without which possibly fine distinctions would not have to be made. But, unless one is prepared to accept that almost any moulded version of a functional object is to be included in the definition, a line has to be drawn somewhere and some form of differentiation made.

73 One can think up any number of marginal examples to test where the boundary lies. Mr Bloch posed the example of a statue of a saint created as an object of veneration for use in a church. Its religious purpose or function would not alter its status as a sculpture. The same goes for props. A sculpture made for use in a play or film does not, he submits, make it any more utilitarian than the statue of the saint and, again, should not affect its status as a sculpture for the purpose of inclusion in the definition of artistic work.

74 None of this is necessarily controversial but we are not convinced that these examples really help. A plaster statue of a saint can, in artistic terms, be very good or very bad. There are many examples of both. But most people would, we think, accept that both kinds were sculptures notwithstanding their religious purpose. Similarly, a well-designed stage prop may be highly artistic and one knows of stage sets for opera and ballet designed by a number of artists of great note. Again their status as an artistic

A work would not be negated by the use to which their designs were intended to be put.

75 The issue in this case and the judge's approach to it does not turn on the purpose for which it is actually used but on the purposive nature of the object: what the judge described [2009] FSR 103, para 118 (vii) as its "intrinsic quality of being intended to be enjoyed as a visual thing". As we read his judgment, the purpose of the object is simply one of the relevant guides to whether it qualifies as a sculpture. A precise definition of that term is not possible which is why the judge has outlined a number of considerations which should act as signposts to the right answer. One can demonstrate this by an example. Most people would not regard a real soldier's helmet as a sculpture. Although made of pressed metal from a mould, its essential functionality as such is to take it outside any reasonable use of that term. A medieval suit of armour, however highly decorated, is no different. Although now of largely historical interest, it was made for a practical purpose which, again, characterises it as an object of utility rather than an artistic work. This view of these objects would not change if they were used as props for a play or film. Their use in that context would not alter their nature or their description.

D 76 But if the soldier's helmet appears on a bronze statue of a soldier as part of an artistic representation of the man and his kit no one would, we think, dispute that it formed part of a sculpture. It has no practical utility. It cannot be used as a helmet and, to that extent, it is not one.

E 77 The result of this analysis is that it is not possible or wise to attempt to devise a comprehensive or exclusive definition of "sculpture" sufficient to determine the issue in any given case. Although this may be close to adopting the elephant test of knowing one when you see one, it is almost inevitable in this field. We therefore consider that the judge was right to adopt the multi-factorial approach which he did.

F 78 We turn then to the second aspect of Mr Bloch's appeal on this point which is whether the judge correctly applied the various guidelines he has set out. In doing so we observe that this is the type of case referred to by Lord Hoffmann in *Designers Guild Ltd v Russell Williams (Textiles) Ltd (trading as Washington DC)* [2000] 1 WLR 2416 in which an appellate court must pay considerable respect to the assessment made by the fact-finding judge and should not reverse his decision unless it is satisfied that he erred in principle.

G 79 The first class of item to consider are the helmet and armour. Mr Bloch seeks to avoid our example of a real soldier's helmet being used as a prop in a film by stressing the fictional and imaginary nature of the stormtroopers and what they were. These were not, he submits, the helmet and armour of a real soldier and are therefore no more part of reality than the horn of a unicorn would be. That is not a real horn and this is not, in any real sense, a helmet.

H 80 But that argument confuses the fictional nature of the stormtrooper with his physical depiction in the film. Although invented, the helmet and armour are still recognisable as such and have a function within the confines of the film as the equipment of the stormtrooper. They are, to that extent, no different from and serve the same purpose as any real helmet or armour used in a film. The judge made this point by referring to the primary function of the helmet and armour as being utilitarian and lacking in artistic purpose.

This is simply a shorthand for the application of the various considerations set out in his para 118. He was, in our view, entitled to come to that conclusion on the facts of this case. We also think that he was right to do so. Neither the armour nor the helmet are sculpture. A

81 That leaves the toy stormtroopers. Mr Bloch submits that the distinction which the judge made based on *Britain v Hanks Bros & Co* 86 LT 764 is untenable and that the facts of that case are indistinguishable from those under consideration on this appeal. The toy stormtroopers would not, of course, have qualified as sculptures under the 1814 Act because they are not statues or models of the human figure but that particular qualification no longer exists. It is, however, clear from the judgment of Wright J that the submission he had to deal with was that the models were toys of no artistic merit whereas, on the evidence, the opposite was the case. B C

82 As already indicated, we think the judge was right to point to the existence of what can loosely be described as a work of art as the key to the identification of sculpture. On this basis, artistic and accurate reproductions of soldiers could qualify notwithstanding that some children might wish to play with them. But in most modern cases toy soldiers, whether real or fictional, will not be works of art and will not differ materially in artistic terms from the plastic Frisbee in the *Wham-O* case [1985] RPC 127. They will be playthings registrable for their design qualities but nothing else. This distinction may be difficult to draw in some cases but we suspect that the cases which will qualify for protection under the Copyright Act will be relatively rare. The judge recognised the need not to make qualitative judgments about the artistic merits of the toy soldiers in *Britain v Hanks Bros & Co* 86 LT 764 compared to the stormtroopers and therefore emphasised the real purpose of the latter being one of play. But the true distinction between the two cases can be expressed in more fundamental terms. We are not dealing here with highly crafted models designed to appeal to the collector but which might be played with by his children. These are mass produced plastic toys. They are no more works of sculpture than the helmet and armour which they reproduce. D E F

Section 51

83 Section 51 was introduced to deal with the problem identified by the House of Lords in *British Leyland Motor Corp'n Ltd v Armstrong Patents Co Ltd* [1986] AC 577. A manufacturer whose product would not qualify for copyright protection because it fell outside the definition of "artistic work" might none the less be able to control the market through the artistic copyright in any drawings of the design. In the *British Leyland* case the issue was the ability of motor manufacturers to limit the production of spare parts in this way which the House of Lords dealt with by upholding a right of repair on the part of the car owner that effectively trumped the manufacturers' copyright. G

84 A perhaps more principled solution came in the form of section 51 of the 1988 Act which provides: H

"Design documents and models

"(1) It is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than an

A artistic work or a typeface to make an article to the design or to copy an article made to the design.”

“(3) In this section—‘design’ means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration; ‘design document’ means any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise.”

B 85 This, as the judge recorded, is directed to the production of a three-dimensional object in accordance with a design which is itself the subject of copyright. Except where the design is one for an artistic work, the use of the design to make what is illustrated is not an infringement.

C 86 The judge held that the McQuarrie paintings and other drawings were design documents within the meaning of section 51 and were used by Mr Ainsworth to create the stormtrooper helmet and armour. On the basis of his finding that the helmet and armour were not sculpture or works of artistic craftsmanship, section 51 therefore provided a defence to a claim of infringement based on his use of those works.

D 87 The judge’s decision that the McQuarrie paintings and drawings were design documents has not been challenged on this appeal. The application of section 51 was resisted only on the ground that the helmets and armour were sculpture. The judge was therefore right to find that it provides Mr Ainsworth with a defence to the UK copyright claim.

Section 52

E 88 The application of section 51 makes it unnecessary for Mr Ainsworth to rely on section 52. We can therefore deal with the point quite shortly.

89 So far as relevant, section 52 provides:

“Effect of exploitation of design derived from artistic work

F “(1) This section applies where an artistic work has been exploited, by or with the licence of the copyright owner, by— (a) making by an industrial process articles falling to be treated for the purposes of this part as copies of the work, and (b) marketing such articles, in the United Kingdom or elsewhere.

G “(2) After the end of the period of 25 years from the end of the calendar year in which such articles are first marketed, the work may be copied by making articles of any description, or doing anything for the purpose of making articles of any description, and anything may be done in relation to articles so made, without infringing copyright in the work.”

“(4) The Secretary of State may by order make provision— (a) as to the circumstances in which an article, or any description of article, is to be regarded for the purpose of this section as made by an industrial process; (b) excluding from the operation of this section such articles of a primarily literary or artistic character as he thinks fit.”

H “(6) In this section . . . (b) references to the marketing of an article are to its being sold or let for hire or offered or exposed for sale or hire.”

90 The reference in section 52(1)(a) to an industrial process is the 50-plus test referred to earlier. This is set out in the Copyright (Industrial Processes and Excluded Articles) (No 2) Order 1989 (SI 1989/1070) which

was made pursuant to the power contained in section 52(4). The Order also A
excludes from the operation of section 52: “(a) works of sculpture, other
than casts or models used or intended to be used as models or patterns to be
multiplied by any industrial process.”

91 This is obviously modelled on and reproduces the provisions of
rule 26 of the Designs Rules 1949.

92 Mr Ainsworth’s case before the judge was that copies of the B
stormtrooper helmet and armour have been reproduced industrially for
more than 25 years. It was conceded by Lucasfilm that the artistic work in
the form of the McQuarrie works had been exploited by the making of
articles by an industrial process; that more than 50 such articles were made
and sold; that the manufacture took place outside the UK; and that the
exploitation took place both before and after the coming into force of the C
1988 Act on 1 August 1989. There was, however, no agreement as to when
precisely the relevant exploitation began or whether it began more than 25
years before Mr Ainsworth produced his own copies.

93 Because exploitation began before 1 August 1989 it is necessary to
look at the transitional provisions contained in the 1988 Act. Section 10 of
the 1956 Act was designed to deal with cases of double protection for a work
both as an artistic work under the 1956 Act and as a registered design. D
Section 10(2) contained provisions similar to section 52 under which a
15-year copyright period applied if works which were subject to copyright
but were also the subject of a corresponding industrial design were exploited
by the production and sale either within the UK or elsewhere of articles to
which the design had been applied.

94 Paragraph 20 of Schedule 1 to the 1988 Act provided:

“(1) Where section 10 of the 1956 Act . . . applied in relation an E
artistic work at any time before commencement, section 52(2) of this Act
applies with the substitution for the period of 25 years mentioned there of
the relevant period of 15 years as defined in section 10(3) of the 1956 Act.

“(2) Except as provided in sub-paragraph (1), section 52 applies only
where articles are marketed as mentioned in subsection (1)(b) after F
commencement.”

95 The net effect of these provisions was that if the 15-year period had
started to run under section 10 of the 1956 Act but had not expired by
1 August 1989, section 52 came into operation in respect of the works in
question but continued to apply a reduced copyright period of 15 years
rather than the 25-year period provided for under section 52.

96 It was a condition for the operation of section 10 that the G
corresponding design should at least be capable of registration under the
1956 Act. Section 10(4) provided:

“For the purposes of subsections (2) and (3) of this section, no account
shall be taken of any articles in respect of which, at the time when they
were sold, let for hire, or offered for sale or hire, the design in question H
was excluded from registration under the 1949 Act by rules made under
subsection (4) of section 1 of that Act (which relates to the exclusion of
designs for articles which are primarily literary or artistic in character);
and for the purposes of any proceedings under this Act a design shall be
conclusively presumed to have been so excluded . . .”

A 97 This is a reference to rule 26 of the 1949 Designs Rules which excluded from registration various classes of work including works of sculpture other than casts or models used or intended to be used as moulds or patterns to be multiplied by any industrial process.

B 98 Because they are not sculptures the production of the stormtrooper toys or, for that matter, the helmet or armour would have started time running under the 1956 Act. The judge held that the 15 years expired before Mr Ainsworth started to make his reproductions in 2004. It is therefore unnecessary to consider the alternative approach under rule 26(1) which depends on whether there was an intention at the date when the initial works were created that they should be exploited in this way. Nor is it necessary to consider the arguments advanced on both sides as to how section 52 might operate were we to have decided that either any one or more of the stormtrooper items was a work of sculpture, or to consider whether a new point raised by Mr Bloch was properly open on the pleadings. Our decision on that point therefore leaves intact the judge's finding that Mr Ainsworth is entitled to rely on a section 52 defence.

Enforcement by English court of US copyright?

D 99 Because Mr Ainsworth is physically within the jurisdiction of the courts of England and Wales, there is no doubt that these courts have "personal" jurisdiction. He was properly served. The question we have to decide is whether the court must, alternatively should, accept what conflicts lawyers called "subject matter" jurisdiction. Must or should this court accept jurisdiction to enforce Lucasfilm's US copyrights against Mr Ainsworth for what he has done and threatens to do by way of sales from here to the US?

F 100 The starting point here is that it is now common ground or undisputed that Lucasfilm does have US copyrights and that Mr Ainsworth has infringed them. The acts which constitute infringement by US law were all actually done in or from the UK. They consist of sales to US customers in the US by despatch of products from the UK, advertising on the Internet and the placing of advertisements in US publications. It would seem that questions of where the property passes, or where the contract was made, or what law governs it and the like are irrelevant under US law. They might not be if the position were the other way round: see e.g. *Badische Anilin und Soda Fabrik v Hickson* [1906] AC 419—under the old law no UK patent infringement by sale and despatch from Germany. It is not necessary to examine whether the concession of infringement according to US law is correct. What is to be noted is that the extent to which US copyright law extends "a long arm" to acts in fact done only in this country is itself a question of American, not English law. Other foreign laws might extend an even longer arm: if they did it would make no difference if jurisdiction here is automatic and compulsory.

H 101 The arguments for subject matter jurisdiction fall under three heads. (a) That the judgment in *Owusu v Jackson* (Case C-281/02) [2005] QB 801 compels it. (b) That this court in *Pearce v Ove Arup Partnership Ltd* [2000] Ch 403 decided that the English courts have subject matter jurisdiction over all acts of infringement of copyright committed anywhere in the world. (c) That, even if subject matter jurisdiction is not compelled,